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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,332	08/08/2001	John Charles DeBraal	0011-0377P	1960

2292 7590 06/17/2003

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,332

Applicant(s)

DEBRAAL ET AL.

Examiner

Christopher P Bruenjes

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10, 17-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

1. Claims 11-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

2. Applicant's election of Group 1 Claims 1-15 and 17-22 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***WITHDRAWN REJECTIONS***

3. The objection to the Specification and the 35 U.S.C. 112 rejections of claims 2, 7-10 and 22 of record in Paper #7, Pages 4-5 Paragraph 6 have been withdrawn due to Applicant's amendment in Paper #9.

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4. The 35 U.S.C. 102 rejections of claims 1-10 and 17-22 of record in Paper #7, Pages 6-7 Paragraph 7 have been withdrawn due to Applicant's amendment in Paper #9.

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The container wall referred to in claim 17 is a container wall of a sleeve that surrounds a container having a beverage containing space. Although the sleeve does enclose a beverage containing space, it does not come in contact with the beverage containing space because the container wall of the container is

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sandwiched between the sleeve container wall and the beverage container space.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-10, 17-21, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neale et al (USPN 6,265,040).

Neale et al teach an insulated beverage container stock material, container, or sleeve having an innermost surface and

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an outermost surface, and container wall including a paper stock layer having an interior surface and an exterior surface, a foam layer and a polyethylene film layer (see abstract and col.2).

The paper layer has a thickness between 10 mils and 26 mils (col.5, 1.12-16), which is within the range of 10-26 and 2-10.

The foam layer is syntactic foam, which is formed from thermoplastic particles, which includes polyethylene particles (col.2, 1.56-67). Neale et al further teaches that paper stock is coated on one side with a thin layer of polyethylene, which makes the cup impervious to moisture and which also seals the cup after the blank (col.2, 1.27-30). Neale et al also teach that foam insulation is added to either the internal or external side of the paper stock material (col.2, 1.45-53). When the foam insulation is added to the internal side of the paper stock material the surface immediately in contact with said beverage-containing space obviously includes a seamless and smooth surface. Neale et al fail to explicitly teach the specific layer order claimed. However, Neale et al teach that a paper stock material forming a paper cup has a polyethylene layer on the inner surface of the paper in order to make the cup liquid and moisture impervious. Neale et al also teach that the foam layer is formed interior of the paper layer. One of ordinary skill in the art would have recognized that the polyethylene

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layer is formed either directly on the inner surface of the paper layer, therefore sandwiching it between the foam and paper layers, or the polyethylene layer is formed on the innermost surface of the container, therefore sandwiching the foam layer between the polyethylene and paper layers. The method of forming or laminating the layers to each other receives little patentable weight in an article claim because the same article structure can be made by lamination or extrusion and articles are only defined by structure.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to arrange the polyethylene, foam, and paper layers taught by Neale et al with the paper layer comprising the outermost surface and the other layers placed with either layer on the innermost surface. Whether the polyethylene or foam is formed as the innermost layer is functionally the same and one having ordinary skill in the art would have recognized that either structural formation would ultimately serve the same functional purpose, absent the showing of unexpected result.

7. Claims 4, 9, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neale et al (USPN 6,265,040) in view of Iioka (USPN 4,435,344).



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Neale et al teach all that is claimed in claims 1, 8, and 17 as shown above, but fail to explicitly teach using foam formed from polyethylene. However, Iioka teaches that the use of polyethylene to form foam insulation for paper cups is well known in the art, and is preferred over other thermoplastic materials (col.3, 1.50-55). One of ordinary skill in the art would have recognized that when forming foam from thermoplastic synthetic resin, such as the foam taught by Neale et al in column 2, lines 62-67, polyethylene including low, medium and high density polyethylene is a well known and preferred resin, as taught by Iioka.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to use polyethylene, which is a well known foam forming material as taught by Iioka, as the thermoplastic for forming the foam of Neale et al, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, absent the showing of unexpected result. *In re Leshin*, 125 USPQ 416.

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**ANSWERS TO APPLICANT'S ARGUMENTS**

8. Applicant's arguments filed in Paper #9 regarding the objection to the Specification and the 35 U.S.C. 112 rejections of claims 2, 7-10, and 22 of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments filed in Paper #9 regarding the 35 U.S.C. 102 rejections of claims 1-10 and 17-22 as anticipated by Sadlier have been considered but are moot since the rejections have been withdrawn.

**Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

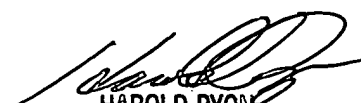
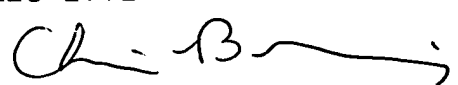
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB  
June 5, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1/12 8/13/03